

REMARKS

I. Status of the Claims

Claims 1, 2, 4, 5, 7-9, 27, 32, 36, 37, 51, 53, 55, 57, 60-62, 64, 66, 73, and 80-84 are currently pending, with claims 80-84 being withdrawn as directed to non-elected subject matter. Claims 1 and 80-84 have been amended to recite, in relevant part, "at least one crosslinked copolymer comprising at least one methacrylic acid unit and at least one C₁-C₄ alkyl acrylate unit, at least one polymer chosen from cationic polymer and at least one water-insoluble solid mineral particle chosen from clays, and particles comprising at least 10% by weight of calcium carbonate." Accordingly, claim 55 has been amended to recite, in relevant part, "at least one polymer chosen from cationic polymers." Support for these amendments can be found in the specification and claims as-filed. Accordingly, no new matter has been added.

Applicants note that the Examiner acknowledged that claims 32 and 37 are pending on page 2 of the final Office Action mailed July 2, 2008. However, the Examiner did not explicitly list claims 32 and 37 in the claim rejections in the final Office Action or the Advisory Action. See final Office Action mailed July 2, 2008, at page 2 and 7; see also Advisory Action mailed September 22, 2008, at page 2. Applicants note that claims 32 and 37 were marked as rejected in the Office Action Summary of the final Office Action, but not in PTOL-303 of the Advisory Action. Accordingly, Applicants respectfully request clarification as to the status of the claims.

II. Rejections under 35 U.S.C. § 103

(a) Rejection based on Commonly Owned Patents and/or Applications

Applicants respectfully acknowledge that the Examiner has withdrawn the rejection of claims 1, 2, 4, 5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,258,852 (the '852 patent) or U.S. Patent Application Publication Nos. 2003/0108503 (the '503 publication) or 2003/0103927 (the '927 publication) or 2004/0001796 (the '796 publication) or 2003/0103929 (the '929 publication) taken individually or in combination with U.S. Patent Application Publication Nos. 2004/0197356 (the '356 publication) or 2004/0197355 (the '355 publication). See Advisory Action at page 2.

(b) Rejection based on Non-L'Oréal Patents and/or Publications

The Examiner maintains the rejection of claims 1, 2, 4, 5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Nos. 6,635,702 (the '702 patent) and 5,580,494 (the '494 patent), as well as WO 2002/096385 (WO '385) and WO 2002/096377 (WO '377) for the reasons set forth in the Advisory Action at pages 2-6. Specifically, the Examiner alleges that the '702 patent "suggests adding calcium carbonate and teaches that the insoluble compounds can be anywhere from 0.1-50%. . ." Advisory Action at page 5. The Examiner further contends that WO '355 and WO '356 "teach[] that the particles are used in rinse-out compositions to improve the feel and appearance of the hair." *Id.* The Examiner concludes:

one of ordinary skill in the art would be motivated to add the cationic polymer [] into the compositions of '702 expecting that the compositions which [have] the acrylic acid/alkylacrylate polymer provides acceptable rheology without significant increase[] or

decrease in viscosity or pH, with no separation settling with extended periods of time and adding the polyethylenimine (cationic conditioning polymer) into the compositions provide conditioning effects which [are] excellent for the keratin and adding calcium carbonate particles would provide the additional benefit of better hair style hold and increased sensation of thickness to the hair.

Id. at page 6. Applicants believe that the Examiner is essentially repeating the original rejection in the Office Action mailed December 31, 2007. See Office Action mailed December 31, 2007, at pages 8-11. Applicants believe that the Examiner is arguing that the '702 patent teaches all the elements of the present claims and the '494 patent, WO '385, and WO '377 merely teach the elected species. Applicants respectfully disagree and traverse for at least the following reasons.

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious."

M.P.E.P. § 2141.02(I) (8th ed. Sept. 2007 Rev.) (emphasis in original) (citations omitted). The '702 patent only broadly discloses, in a laundry list of possible ingredients, cationic polymers which "can optionally be utilized." The '702 patent at col. 11, lines 36-53 (emphasis added). Additionally, insoluble calcium carbonate and clay are just one of many ingredients listed under "other insoluble compounds." The '702 patent at col. 8, lines 54-67. The '702 patent provides no direction as to why or how one skilled in the art would selectively choose cationic polymers or calcium carbonate over other ingredients. Such picking and choosing of elements is improper. See *In re Arkley*, 455 F.2d 586,587 (C.C.P.A. 1972) ("the . . . reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the

compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference") (emphasis in original).

Further, an examiner must “[c]onsider any teachings of a ‘typical,’ ‘preferred,’ or ‘optimum’ species or subgenus within the disclosed genus.” M.P.E.P. § 2144.08. That analysis necessarily includes those exemplified compositions that are dissimilar from those presently claimed: “[s]uch a teaching may weigh against selecting the claimed species or subgenus and thus against a determination of obviousness.” M.P.E.P. § 2144.08 (citing *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994)). In this case, none of the seventeen Examples in the ‘702 patent contain at least one water-insoluble solid mineral particle chosen from clays and particles comprising at least 10% by weight of calcium carbonate, as required by the present claims. Moreover, the Examiner has provided no reason “to select the claimed species or subgenus from the disclosed prior art genus” in the ‘702 patent. M.P.E.P. § 2144.08.

Additionally, under KSR, an “obvious to try” rationale for *prima facie* obviousness can only be supported when there is a “finite number of identified, predictable potential solutions to the recognized need or problem.” M.P.E.P. §2143(E). Even a layperson, and certainly one of ordinary skill in the art, knows that personal care products vary widely in terms of formulation of ingredients depending on the desired use, texture, appearance, etc., and that not all ingredients will be compatible or interchangeable. The possible ingredients in hair compositions generally, cannot be considered “finite” the way the term was used in KSR to describe the location of a sensor on a pedal. See, e.g., 82 USPQ2d at 1397.

Further, one would not attempt to simply modify an optional cationic polymer or the amount of an optional insoluble compound listed in the '702 patent with specific groups taught in the '494 patent, WO '385, and WO '377, as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 2, 2008

By:



Anthony A. Hartmann
Reg. No. 43,662
(202) 408-4000